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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIMBALL C. CHEN, ALEXANDER W. EVANS,
and DANIEL E. SHPRECHER

Appeal 2010-000055
Application 10/662,940
Technology Center 3600

Oral Hearing Held: January 20, 2011

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Thursday, January 20, 2011 commencing at 10:19 a.m., at the U.S. Patent and Trademark

Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo, Notary Public.

PROCEEDINGS

JUDGE LORIN: Good morning, Ms. Song. Counsel, we're familiar with the record. When you are ready, you may proceed. You have 20 minutes.

MS. SONG: Thank you very much. Good morning. My name is Yisun Song. I'm with the law firm of Hunton & Williams. I'm here today on behalf of our client ETGI to discuss the merits of this pending application.

I would like to address just a couple of points this morning and I will start with a brief summary of the pending claims and then I'll address the 103 rejections.

The pending claims are directed to a system and method for automatically generating a message to control remote devices. The claims recite a recursive method where an informational message is generated in response to operational characteristics of remote devices. The pending application was filed September 2003 and claims priority as far as back as January 1999.

There are two independent claims and 11 dependent claims at issue and the remaining claims have been withdrawn.

Claim 1 recites a computer-implemented method and claim 1A recites a computer-implemented system. There are two main steps for these independent claims. The first step requires automatically generating one -- at least one informational message at a central server responsive to some type of operational characteristic of the remote devices.

The second step requires transmitting the informational message to a communication device where the communication device initiates an action from the remote devices.

So we have three components. One a central server that automatically generates the informational message; two, a communication device that receives the informational message and then controls the remote devices; and three, the remote devices themselves that provide operating characteristics to the central server so that the central server can then automatically generate the informational message.

So the remote devices are monitored and that monitored data is used by the central server to then automatically generate informational messages to control the remote devices. So you see that there is a recursive feature to the claimed invention.

In addressing the claims the Examiner relies on a combination of two patents, the Brown patent and the Woodard patent. Brown does not disclose this recursive feature. The Examiner alleges that Brown shows all the claim limitations except for the server. However, this is not accurate.

Brown does not show this automatic generation of an informational message at a central server responsive to some type of operational characteristic of remote devices.

To address this feature, the Examiner relies on Brown's discussion of a central computer 24 providing signals to transmitter 20 which in turn provides paging messages to controllers 14. These messages may cause certain appliances to be turned off. At best Brown discloses a one-way communication channel for sending paging signals from a computer to a controller.

Brown does not monitor the remote devices nor does it use any monitored data to generate the pages to control the remote devices. Rather, Brown's central computer operates on a predetermined schedule. According to Brown, the controller schedules each device to be operated pursuant to the program schedule. As defined by Brown, the schedule refers to scheduling the time of day and appropriate times for device operation.

Alternatively, Brown very clearly states that the user of the system may cause a paging message to be provided at any time. Thus, Brown teaches that the remote devices may be controlled in three ways, one by a predetermined schedule which refers to day and time of operation, two as determined by a user or, three, as determined by a utility company.

It does not automatically control remote devices responsive to any operating characteristic of the actual remote devices themselves. There is no recursive feature in Brown. The paging system relied upon by the Examiner can only generate one-way pages from the computer to the devices.

There is no way to automatically generate a message responsive to the operating characteristics of the devices because Brown does not monitor the remote devices for the purpose of generating the paging messages.

In attempting to address this claim, the Examiner appears to ignore the requirement that the informational message is generated responsive to the remote devices.

During patent examination the pending claims must be given the broadest reasonable interpretation consistent with the specification. Each claim limitation must have meaning and cannot be interpreted to be devoid of any meaning.

The Examiner has the burden to show where in the reference each claim limitation is found. The Examiner must meet this burden, however, without interpreting claims in a manner that would render any limitation meaningless.

In the Examiner's answer at page 6 the Examiner relies on Brown column 4, lines 4 through 18, which makes clear that the central computer generates pages that are not responsive to any operating characteristic of the remote devices.

From their relied-upon excerpt, Brown clearly teaches that the central computer provides signals to the transmitter. The paging messages are generated as a result of actions by the central computer. There is nothing from these passages from Brown that indicates that the central computer generates pages responsive to any operating characteristics of the remote devices. There is no recursive feature in Brown.

JUDGE FISCHETTI: Counsel, you've said now several times recursive. I'm looking in the claim and I assume by recursive you mean a feedback loop type of recursive?

MS. SONG: Yes, exactly.

JUDGE FISCHETTI: That would, to me, strike some sort of cyclic reiterative language. I don't see that. Maybe you could show me.

MS. SONG: Sure. Absolutely. In claim 1, for example, we say automatically generating at least one informational message at a server and then we have the phrase "responsive to" and then we go into a couple of different ways one or more of resource consumption, resource production, operating characteristics or operational state of at least one device of the plurality of remote devices.

So the automatic generation has to be responsive to one of those characteristics of the remote devices. What Brown teaches is some sort of user intervention or some sort of preestablished, predetermined program that generates the paging messages.

JUDGE FISCHETTI: Wouldn't that be an operational state of preprogrammed operational state, customized operational state that it's responding to?

MS. SONG: Well, the predetermined schedule has to do -- according to Brown, has to do with day and time of operation. That, we believe, is separate from the actual operating characteristic of the remote devices. A predetermined schedule as Brown really tells you when and what time and during the time frame of operation of the remote devices. If you were to go on vacation or at night if you don't need to turn on the heater, you can --

JUDGE FISCHETTI: So you are going from on to off or off to on, right? You are changing states according to a schedule?

MS. SONG: It's a predetermined schedule and it's not responsive to the actual remote devices and how they operate. And that's what the claims are trying to --

JUDGE FISCHETTI: Assuming -- where is the reiterative aspect of this? We understand that it's responsive but you say that it's recursive, and so where after this one event in the claim do I see the continuing cyclic of these events?

MS. SONG: I used the term recursive because I didn't want to have to repeat the entire claim language, but what I meant by recursive is that the informational message is generated responsive to the remote devices and that can change. That can kind of keep going over time.

According to Brown, it's on a predetermined schedule. The user can say send this page message now and control the device. Here it can continuously happen as it's monitoring the devices, as the device is changing in operation. The informational message that controls the device will also, in turn, change as well.

JUDGE FISCHETTI: So it's a feedback but I don't see where it's claimed as that, unfortunately.

MS. SONG: Well, we believe the term "responsive to" would have to imply that the -- and in conjunction with the term "automatically generating" the message has to be automatically generated responsive to these operating characteristics of the remote devices. So that precludes any sort of user intervention, any sort of preprogram schedule.

JUDGE FISCHETTI: When you say it precludes user intervention, I look at column 4 and it says that the utility command center computer provides signals to a transmitter. So that statement is said exclusive of human intervention as it's written. So why would I want to assume that there is human intervention in the text when it's not there?

MS. SONG: Well, I believe the text shows that it can be controlled in three different ways, by program schedule or where it says "of the user of the system." And for example, they provide a utility company. But it requires some sort of intervention, at the request of the utility company or as programmed by the utility company. The system itself doesn't automatically generate it in response to monitored remote devices.

JUDGE FETTING: You are not saying it's exclusive. I don't see exclusively. I don't see anything in any language that excludes it being

responsive to something else in addition to what's claimed. So it could be responsive to what's claimed based upon the way it was programmed.

MS. SONG: Well, the programming, we believe, would take it outside of the scope of the claims because we're saying it's responsive to the operating characteristics of the device. If you program it, you are telling it when to work and at what time.

JUDGE FETTING: Not necessarily.

MS. SONG: That's all that Brown teaches. Brown teaches a schedule and it says time and day and then time frame. That's all it says about the program schedule. And the Examiner hasn't cited anything else that would say that it goes beyond that. We're taking schedule to mean time of day and time frame of operation of whatever devices.

JUDGE FISCHETTI: You know, I set my alarm clock last night and this morning it automatically went off at 5:30. But last night I programmed it to go off. So I humanly intervened and set the program last night and then this morning the machine automatically took those instructions and went off. I read Brown the same way.

MS. SONG: That's not how we read Brown. I guess the way that our invention would work in your example is if rather than you intervening and say what time that you need to wake up, the system would monitor -- would have to monitor a device and see how it operates and then it would wake you up.

I'm not really sure how that would apply in this situation because I don't think that's a really good parallel but it would not require you to say, This is when I want to wake up. It would monitor. Maybe it would know from your schedule or it would know from some other source that that's

when you normally wake up and then it would wake you up. It wouldn't require user intervention.

And the patent talks about a lot of different ways of doing this, however, we've narrowed the claim. So we're taking out the program schedule, user intervention. We're saying you monitor the remote devices. Based on how it's operating, you can then automatically generate these informational messages to then control, adjust, realign these remote devices.

I think I have addressed most of the rest of my points here. I just want to touch upon the Woodard patent that was applied by the Examiner as recognized by the office action. Brown does not disclose a server as required by the claims. However, as a server an element is admittedly missing from Brown.

Brown also fails to disclose the automatic generation of the informational message because this function must occur at the central server.

The office action relies on the Woodard reference to address these admitted deficiencies. However, Woodard merely collects and displays data from multiple facilities. And just as Brown, Woodard does not disclose this automatic generation of an informational message at a central server responsive to operating characteristics of remote devices. The server in Woodard simply does not provide this claim functionality.

Those are all the points that I wanted to make today. On behalf of our client, ETGI, I thank you for the opportunity.

JUDGE FETTING: Thank you.

JUDGE LORIN: Thank you very much, counsel.

(Whereupon, the proceedings at 10:33 a.m., were concluded.)